

PATENT

IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE



Serial No.: 10/074,535 )  
Filed: November 13, 2001 )  
For: HYDRAULIC PUNCH )  
DRIVER )  
Inventors: NORDLIN et al. )  
Art Unit: 3722 )  
Examiner: Not Yet Assigned )  
Attorney Docket No.: 913/38954/283 )

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on

April 16, 2003

Dated

Tiffany E. Sexton

Tiffany E. Sexton

**PETITION TO COMMISSIONER FOR PATENTS UNDER 37 C.F.R. 1.181 and 1.182  
REGARDING APPLICANT'S PETITION FOR RETROACTIVE LICENSE**

Commissioner for Patents  
Washington, D.C. 20203

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Sir:

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Applicant makes this Petition to the Commissioner because no decision regarding Applicant's "Petition For Retroactive License (37 CFR §5.25)", which was mailed to the United States Patent and Trademark Office on February 19, 2002, has yet been made. Thus, Applicant respectfully requests that Applicant's petition for license for foreign filing be granted retroactively under the provisions of 37 CFR §5.25 to December 27, 2001.

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**Chronology Of Events**

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On February 19, 2002, Applicant mailed a "Petition For Retroactive License (37 CFR §5.25)" to the United States Patent and Trademark Office, along with the appropriate fee of \$130.00. A copy of this Petition is attached hereto as Exhibit K (Please note that the Exhibits hereto start with "K" in order to avoid confusion because the attached Exhibits have many numbered and lettered exhibits attached thereto as well).

The "Petition For Retroactive License (37 CFR §5.25)" explains the following:

1. A formal United States patent application was filed on November 13, 2001 and claimed priority from United States provisional patent application Serial No. 60/259,947, which was filed on January 5, 2001;

PATENT



IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

Serial No.: Not yet assigned )  
Filed: November 13, 2001 )  
For: HYDRAULIC PUNCH DRIVER )  
Applicant: William F. Nordlin et al. )  
Examiner: To be assigned )  
Art Unit: To be assigned )  
Based Upon )  
U.S. Provisional Application Serial No. 60/259,947 )  
Filed January 5, 2001 )  
Attorney Docket No.: 913/38954/283 )

I hereby certify that this correspondence is being deposited with the United States Postal Service first class mail in an envelope, addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on February 19, 2002

James A. O'Malley, 45, 952  
Name of applicant, assignee or Registered Rep.  
James A. O'Malley 2/19/02  
Signature Date

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OFFICE OF PETITIONS

Assistant Commissioner for Patents  
Washington, D.D. 20231  
ATTENTION LICENSING AND REVIEW

**PETITION FOR RETROACTIVE LICENSE (37 CFR §5.25)**

**1. Petition**

It is respectfully requested that this petition for license for foreign filing be granted retroactively under the provisions of 37 CFR §5.25 to December 27, 2001. A copy of the subject matter for which this petition is requested is attached hereto as Exhibit A.

**2. United States Application**

The formal United States patent application was filed on November 13, 2001 and has not yet been assigned a Serial No. This application is based upon United States Provisional application Serial No. 60/259,947 which was filed on January 5, 2001.

**3. Previous License**

Attached hereto as Exhibit B is a copy of a foreign filing license which was granted on January 3, 2002 in connection with a Petition For Expedited Foreign Filing License based on the United States application filed on November 13, 2001.

**4. Filed Foreign Application**

An unlicensed patent application was filed in Germany on December 28, 2001.

2. Applicant received a foreign filing license which was granted on January 3, 2002 in connection with a Petition For Expedited Foreign Filing License based on the United States application filed on November 13, 2001; and
3. An unlicensed patent application, which claimed priority from the two aforementioned United States application, was filed in Germany on December 28, 2001.

One of Applicant's attorneys, Mr. James A. O'Malley, also signed a Declaration in accordance with 37 CFR §5.25(a)(3)(i)-(iii).

Thus, Applicant's requested that a license for foreign filing be granted retroactively to December 27, 2001.

In response thereto, the United States Patent and Trademark Office issued a communication on May 6, 2002 regarding its decision on the petition for retroactive foreign filing license. A copy of the communication is attached hereto as Exhibit L.

The communication denied the petition because the petition was defective since the requirements set forth in 37 CFR §5.25(a)(3)(iii) had not been met. The decision explained that:

The declaration of James O'Malley does not suffice to constitute filing of the application abroad through error and without deceptive intent. What is required is a verified statement from the person or persons who had knowledge and made the actual decision to file. Specifically, it is suggested that a verified statement from the German person or persons who actually had knowledge and filed the application in Germany, be obtained.

Soon thereafter, on May 28, 2002, Applicant filed a "Supplement To Petition For Retroactive License (37 CFR §5.25) Filed On February 19, 2002". A copy of the Supplement is attached hereto as Exhibit M.

In the Supplement, and in response to the communication issued by the United States Patent and Trademark Office, Applicant provided the Declaration of Jürgen Klinghardt to satisfy 37 CFR §5.25(a)(3)(iii) which explains how the German patent application was filed abroad through error and without deceptive intent prior to the issuance of the foreign filing license. Thus, Applicant requested that in view of the Declaration of Mr. Klinghardt and the information provided in the original Petition, that the petition for license for foreign filing be granted retroactively to December 27, 2001. Applicant further stated that it was believed that no fee was

due for the filing of the Supplement, but, if a fee was due, the Commissioner was authorized to charge payment of any fees associated with the Supplement to Deposit Account No. 20-1495.

Thereafter, Applicant received no further communication from the United States Patent and Trademark Office regarding the Petition for Retroactive License.

On August 28, 2002, Applicant mailed a "*Status Inquiry*" to the United States Patent and Trademark Office regarding the status of the Petition for Retroactive License. A copy of the "*Status Inquiry*" is attached hereto as Exhibit N. No response to the "*Status Inquiry*" was received.

On November 19, 2002, Applicant mailed a "*Second Status Inquiry*" to the United States Patent and Trademark Office regarding the status of the Petition for Retroactive License. A copy of the "*Second Status Inquiry*" is attached hereto as Exhibit O. No response to the "*Second Status Inquiry*" was received.

On March 19, 2003, Applicant mailed a "*Third Status Inquiry*" to the United States Patent and Trademark Office regarding the status of the Petition for Retroactive License. A copy of the "*Third Status Inquiry*" is attached hereto as Exhibit P.

On April 1, 2003, the United States Patent and Trademark Office issued a communication which stated "We project that this application will be first examined in 3 to 6 months from today." A copy of the communication is attached hereto as Exhibit Q. It appears that this communication was issued in response to the filed Status Inquiries, although it does not answer the question of the filed Status Inquiries. Rather it answers the question of when the application will first be examined, which was an inquiry that Applicant had not made to the United States Patent and Trademark Office.

Conclusion

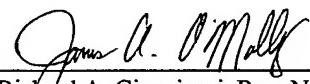
Thus, in view of the foregoing, Applicant respectfully requests that Applicant's petition for license for foreign filing be granted retroactively under the provisions of 37 CFR §5.25 to December 27, 2001.

Applicant has enclosed herewith a check in the amount of \$130.00 to cover the fee for a Petition to the Commissioner. Should the amount be deficient in any manner, authorization is provided to the Commissioner to charge payment of any further fees associated with the Supplement to Deposit Account No. 20-1495.

Respectfully submitted,

TREXLER, BUSHNELL, GIANGIORGI,  
BLACKSTONE & MARR, LTD.

Date: April 16, 2003

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